



COPY OF PAPERS
ORIGINALLY FILED

Receipt
PATENT
18810-81609

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Carol W. Readhead and Robert Winston
Serial No. 10/054,143
Filed: November 12, 2001
For: KIT FOR TRANSFECTION, STORAGE AND TRANSFER
OF MALE GERM CELLS FOR GENERATION OF
TRANSGENIC SPECIES
Examiner: Unknown
Unit: 1632

**REQUEST FOR CORRECTION OF FILING RECEIPT
FOR PTO MISTAKE (37 C.F.R. . § 1.322 (a))**

Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, D. C. 20231

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS	
WASHINGTON, D.C. 20231, ON	<u>August 15, 2002</u> DATE
BY <u>Christina Long</u>	
(DATE OF SIGNATURE)	<u>August 15, 2002</u>

Dear Sir or Madam:

Applicant requests correction of Filing Receipt concerning the above-
referenced application to indicate the correct named applicants, and the correct order, as
indicated in the enclosed marked-up version of the filing receipt (Exhibit A) from:

Robert Winston, London, UNITED KINGDOM;
Carol W. Readhead, Pasadena, CA;
Outi Hovatta, Espoo, FINLAND;

to:

Carol W. Readhead, Pasadena, CA;
Robert Winston, London, UNITED KINGDOM.

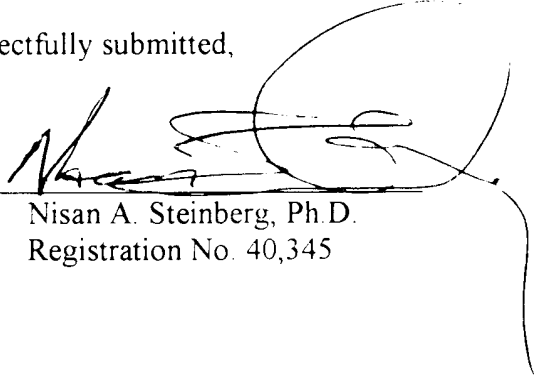
Support for this request, including the deletion of Outi Hovatta as a
named co-inventor, is found in a copy of Petition Under § 1.48(b)(1) for Correction of

Inventorship filed on March 19, 1999 (enclosed as Exhibit B), in parent application 09/191,920, filed November 13, 1998, which issued as U.S. Patent No. 6,316,692 B1 on November 13, 2001. Also enclosed is a copy of the Preliminary Amendment filed on March 19, 1999 in 09/191,920 (Exhibit C), in which Outi Hovatta was deleted as an inventor, in view of an amendment to the claims. Both of these documents (Exhibits B and C) were filed with the above-referenced application on November 12, 2001, and Dr. Hovatta was not named as a co-inventor in Applicant's transmittal.

The Commissioner is hereby authorized to credit overpayments or charge any fees required under 37 C.F.R. 1.16 or C.F.R. 1.17 to Deposit Account No. 50-1597.

Respectfully submitted,

By:


Nisan A. Steinberg, Ph.D.
Registration No. 40,345

SIDLEY AUSTIN BROWN & WOOD
555 West Fifth Street
Los Angeles, California 90013-1010
Ofc: 213/ 896-6663
Fax: 213/896-6600



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY DOCKET NO.	DRAWINGS	TOT CLAIMS	IND CLAIMS
10/054,143	11/12/2001	1632	370	18810-81609		11	1

CONFIRMATION NO. 6154

FILING RECEIPT



OC00000007806967

SIDLEY AUSTIN BROWN & WOOD
555 West Fifth Street
Los Angeles, CA 90013-1010

Date Mailed: 04/05/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

~~Robert Winston, London, UNITED KINGDOM;~~ Change to:~~Carol W. Readhead, Pasadena, CA;~~~~Outi Hovatta, Espoo, FINLAND;~~

Carol W. Readhead, Pasadena, CA;

Robert Winston, London, UNITED KINGDOM.

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A DIV OF 09/191,920 11/13/1998 PAT 6,316,692
WHICH CLAIMS BENEFIT OF 60/065,825 11/14/1997

Foreign Applications

If Required, Foreign Filing License Granted 04/05/2002

Projected Publication Date: 07/18/2002

Non-Publication Request: No

Early Publication Request: No

** SMALL ENTITY **

Title

Kit for transfection, storage and transfer of male germ cells for generation of transgenic species

Preliminary Class

800

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Dated March 19, 1999

In re application of: Readhead et al
Serial No: 09/191,920
Filed: November 13, 1998
For: TRANSFECTION STORAGE AND TRANSFER OF MALE GERM
CELLS FOR GENERATION OF TRANSGENIC SPECIES &
GENETIC THERAPIES

Examiner: Unassigned
Unit: 1643

PETITION UNDER § 1.48(b)(1) FOR
CORRECTION OF INVENTORSHIP

Assistant Commissioner for
Patents
Washington, D. C. 20231

HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS WASHINGTON, D. C. 20231 ON <u>March 19, 1999</u>	
BY <u>[Signature]</u>	DATE <u>March 19, 1999</u>
ANN WEISS	
DATE OF SIGNATURE	

Dear Sir:

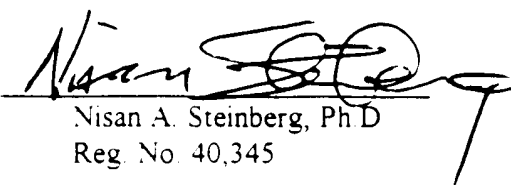
Applicants respectfully petition for correction of the inventorship of the above-captioned utility patent application. Specifically, the deletion of the name of **OUTI HOVATTA**. The Applicants acknowledge that Outi Hovatta's invention is no longer being claimed in the application due to the cancellation of claims 126 through 130 and the amendment of claim 114 in a Preliminary Amendment filed herewith.

The requisite fee of \$130.00 under 37 C.F.R. § 1.17(i) is made herewith in compliance with 37 C.F.R. § 1.48(b)(2). The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required, or to credit any

overpayment, to Deposit Account No 16-2460. A duplicate copy of this petition is enclosed.

Respectfully submitted,

PRETTY, SCHROEDER & POPLAWSKI

By: 
Nisan A. Steinberg, Ph.D
Reg. No. 40,345

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Fax: 213/489-4210

PDMA PCDOCS\DOCS\4161

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Date March 19, 1999

In re application of: Readhead et al

Serial No 09/191,920

Filed November 13, 1998

For: TRANSFECTION STORAGE AND TRANSFER OF MALE GERM
CELLS FOR GENERATION OF TRANSGENIC SPECIES &
GENETIC THERAPIES

Examiner Unassigned

Unit 1643

PRELIMINARY AMENDMENT

Assistant Commissioner for
Patents
Washington, D. C. 20231

<small>HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS WASHINGTON, D. C. 20231 ON</small>	
<small>March 19, 1999</small>	
<small>DATE</small>	<small>DATE</small>
<small>BY</small>	<small>ANN MEISE</small>
<small>March 19, 1999</small>	
<small>DATE OF SIGNATURE</small>	

Dear Sir:

In connection with the above-captioned application, please enter the
following amendments:

In the Specification:

Page 10, line 13, change "transfection agent" to --transfecting agent--

Page 20, line 18, change "Schmit" to --Schmidt-- in the two places it
appears.

In the claims

Please cancel claims 126 through 130 without prejudice

Please amend the following claim as follows

114 (Amended) A kit for the transfection [and storage] of a male vertebrate's germ cells, [comprising] containing the component(s) of a transfection mixture, [said transfection mixture] comprising at least one transfecting agent, and optionally a genetic selection marker, whereby said kit may be used to transfect [and store] said germ cells [in a viable condition]

Request is made for correction of inventorship under 37 C.F.R. §1.48(b), deleting the name of OUTI HOVATTA.

Request has also been made to the Application Processing Division's Customer Correction Branch to place Carol W. Readhead, Pasadena, CA as the first inventor, followed by Robert Winston, London, United Kingdom, as they appeared on the cover page of the application filed November 13, 1998

REMARKS

The amendment at page 10, line 13, is supported, for example, at page 10, lines 18 and 22.

The amendment to claim 114 is supported, for example, at page 5, lines 25-28

The amendment at page 20, line 18 is to correct a typographical error.

Deletion of **OUT HOVATTA** from this application is made necessary by the cancellation of claims 126 through 130 (and the amendment to claim 114). Dr. Hovatta is not a co-inventor of the remaining claims.

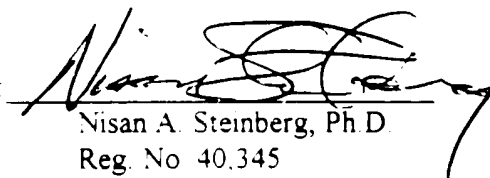
This is also stated in the accompanying petition filed in compliance with 37 C.F.R. § 1.48(b)(1). Payment of the requisite fee under 37 C.F.R. 1.17(i) is made herewith in compliance with 37 C.F.R. § 1.48(b)(2).

Therefore, a first office action not having been received, applicants respectfully request that these preliminary amendments be entered.

Respectfully submitted,

PRETTY, SCHROEDER & POPLAWSKI, P.C.

By


Nisan A. Steinberg, Ph.D.
Reg. No. 40,345

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CDMA PCDOCS DOCS 4141